



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/047,136	01/15/2002	Kwang Koo Jee	15220	4241
7590	06/24/2004		EXAMINER	
Scully, Scott, Murphy & Presser 400 Garden City Plaza Garden City, NY 11530			WYSZOMIERSKI, GEORGE P	
			ART UNIT	PAPER NUMBER
			1742	

DATE MAILED: 06/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/047,136	JEE, KWANG KOO
	Examiner George P Wyszomierski	Art Unit 1742

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 20040521.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 21-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 21-41 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner. *See page 2.*
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 1742

1. The Request for Continued Examination (RCE) filed May 21, 2004 has been processed and is acceptable. The request included amendments to the specification, as well as an amendment canceling all of the pending claims (1-20) and substituting a new set of claims (21-41). An action on the merits follows.

2. The proposed amendments to the specification filed May 21, 2004 are objected to for the following reasons:

a) In the first line of the revised paragraph beginning at page 1, line 6, the word "top" is clearly meant to read "to".

b) Applicant has requested that certain paragraphs be revised, including those beginning at page 6, line 15, page 10, line 11, page 10, line 22, and page 11, line 5. However, in the current specification on file in this application (as filed January 15, 2002), a paragraph does not begin at any of those locations.

3. Claims 34, 35 and 41 as amended May 21, 2004 are objected to. In line 2 of each of these claims, the word "is" is clearly meant to read "are". Correction is required.

4. Claims 21-41 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a) The following recitations in the claims lack proper antecedent basis:

i) Claim 21, line 4--"the member made of shape memory alloy".

- ii) Claim 25, line 3--“the member made of superelastic alloy”.
- iii) Claim 28, line 3--“the member made of shape memory alloy”.
- iv) Claim 36, line 4--“the member made of superelastic alloy”.

b) In claim 23, lines 2 and 5, the recitations of “the annular pipe” lack proper antecedent basis. Applicant may have intended for this claim to be dependent from claim 22 (which would provide antecedent basis for “the annular pipe”), rather than from claim 21 as presently drafted.

c) Claim 29 appears to be inconsistent with independent claim 28. Claim 28 recites a method of joining a member to a hollow member to be fixed at another part of a frame, implying that the hollow member is fixed at the other part of the frame after the recited method. Claim 29, on the other hand, specifies a step of fixing the hollow member at another part of the frame before the first recited step of the method of claim 28. Clarification is required as to the order of the steps in the claimed process.

d) Claims dependent upon any of the above are likewise rejected under this statute.

5. The prior art of record does not disclose or suggest a process as recited in any of independent claims 21, 25, 28 or 36. Therefore, correction of all of the above-noted objections and rejections of the claims under 35 USC 112 should result in allowance of all pending claims (21-41).

Art Unit: 1742

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to George Wyszomierski whose telephone number is (571) 272-1252. The examiner can normally be reached on Monday thru Friday from 8:00 a.m. to 4:30 p.m. Eastern time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King, can be reached on (571) 272-1244. Effective October 1, 2003, all patent application related correspondence transmitted by facsimile must be directed to the central facsimile number, (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



GEORGE WYSZOMIERSKI
PRIMARY EXAMINER

GPW

June 21, 2004